



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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R-2000-122

DEC 12 2000

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading question 3 of the morning section and questions 16 and 36 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner originally scored 69. On July 28, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

**OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional points on the Examination. No credit has been awarded for morning question 3 and afternoon questions 16 and 36. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E).

(E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (B) is correct because statement in answer (D) is incorrect.

Petitioner contends that according to the MPEP and 37 CFR 1.75, “a multiple dependent claim shall refer to such other claims in the *alternatively only*.” Petitioner further maintains that it is incorrect to conclude that a multiple dependent claim can refer to *all* of the limitation of *each* of the particular claims to which it refers.

Petitioner’s argument has been fully considered but is not persuasive. Petitioner cited the MPEP correctly, however, mis-interpreted the rule. Answer (D) contains the same language as in the rule. According to 37 CFR 1.75(c), “a multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.” Petitioner mis-interprets the rule that a multiple dependent claim is construed to incorporate by reference all the limitations of all the claims that the multiple dependent claim refers to. The MPEP 608.01 sets forth the proper interpretation of the rule as cited by the petitioner. Therefore, answer (E) is the best answer because both answers (B) and

(D) are correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

(A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.

(B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

(C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.

(D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.

(E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that the correct answer is (E). Petitioner contends that the MPEP § 2141.03 does not discuss simultaneous inventions and the cases, *Merck*, and *Newell*, were not discussed in the MPEP as a precedent for determining the level of ordinary skill in the art.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)." *Monarch Knitting* stated "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art" at 1983, referring to *Merck*. Furthermore, "[t]he fact of near[-]simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art." *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 443 (US Cl.Ct, 1968). Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is **true**?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.

(E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

Answer (B) is correct, see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that there is no correct answer to this question and credit should be given for all answers. Petitioner contends that the answer (B) is not correct because 37 CFR 10.11(b) violates the Due Process Clause of the U.S. Constitution and answer (B) is ultra vires.

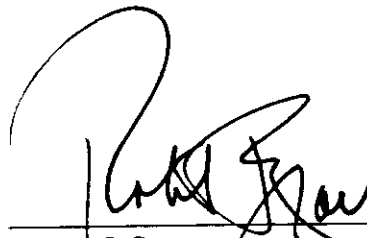
Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (C). Furthermore, contrary to petitioner's argument that 37 CFR 10.11(b) violates the Due Process Clause and the answer (B) is ultra vires, the letter sent by the Director of Enrollment is a notice and the letter is sent for the purpose of ascertaining whether they wish to remain on the register. 37 CFR 10.11(b) also provides that the name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in 37 CFR 1.21(a)(3). No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar  
Director, Office of Patent Legal Administration  
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